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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,880	02/08/2001	Paul Mariaggi	PET-1916	6684

7590 12/01/2003

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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/778,880

**Applicant(s)**

MARIAGGI ET AL.

**Examiner**

Melanie D. Bissett

**Art Unit**

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6,10,12-17,19-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,10,12-17,19,21-28 and 31-34 is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☒ Claim(s) 6 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

1. Upon reconsideration, the present Office action includes a rejection of claim 29 based on prior art. The present action also includes a claim objection.

***Claim Objections***

2. Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 20 recites the language found in claim 1 but does not further limit the claim.
3. Claim 6 is objected to as being dependent on a cancelled claim.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nava in view of Faber et al.
6. Nava discloses a resin used to line surfaces of pipes or wells that includes a polyester resin or vinyl ester resin (col. 2 lines 55-60; col. 3 lines 43-60). Suitable unsaturated polyester resins are made by reacting acids or anhydrides with polyols, including the same specific monomers noted by the applicant (col. 3 line 61-col. 4 line 35). The unsaturated polyester resins form active hydrogen-containing materials to be reacted with the polycarbodiimide component (see examples). The use of "unsaturated

polyesters" indicates the presence of a reactive multiple bond capable of further reaction with other reactive multiple bonds. Although claim 29 only specifies that the polyester resin be *capable* of reaction with another reactive bond, it is noted that the use of unsaturated monomers is also encompassed in the reference (col. 7 lines 33-50). Because the reference reacts the same monomers employed by the applicants, it is the examiner's position that the resulting polyester would have the same dynamic viscosity as that of the applicant's invention.

7. Nava notes gelation at a temperature of 90 °C (see examples) or below (col. 10 lines 12-17) and indicates the use of inhibitors (col. 8 lines 30-56). However, the reference does not indicate the perform having the applicant's claimed residual latent period. Faber teaches that inhibitors are conventionally used to prevent premature gelation and thus prolong shelf life. Thus, it would have been *prima facie* obvious to include inhibitors in the compositions of Nava to prevent premature gelation and improve shelf life. The amount or type of inhibitor could have been modified without undue experimentation to yield the claimed residual latent period.

***Allowable Subject Matter***

8. Claims 1, 10, 12-17, 19, 21-28, and 31-34 are allowed.
9. The examiner's reasons for allowance can be found in the Office action dated 6/3/03, paragraph 8.

***Response to Arguments***

10. Applicant's arguments with respect to claim 29 has been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539 or (571) 272-1068 after December 2003. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
RABON SERGENT  
PRIMARY EXAMINER

mdb